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OFFICE OF PETITIONS

In re Application of :
Heyse et al. :
Application No. 09/182,499 : ON PETITION
Filed: 30 October, 1996 :
Atty Docket No. 060942-0268-US :

This is a decision on the petitions filed on 9 September, 2003, under 37 CFR 1.181 to withdraw the holding of abandonment and under 37 CFR 1.137(b),¹ to revive the above-identified application.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The petition to withdraw the holding of abandonment is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The application became abandoned on 17 December, 2000, for failure to timely reply to the Office Communication mailed on 16 November, 2000, which set a one (1) month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 15 August, 2001.

Petitioners request withdraw of the holding of abandonment in that the response filed on 19 July, 2000, was a proper reply.

Petitioner concededly received the Office communication mailed on 16 November, 2000, but failed to provide the necessary and timely reply. The failure to supply the proper reply was the fault of petitioner, not the USPTO. As noted in *Brenner v. Ebbert*:²

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petition had received the reasonable notice required so as to ensure a timely and full response to the Notices. That petitioner failed to timely and adequately respond was unfortunate, but such failure did not operate to save this application from abandonment.

As such, the petition to withdraw the holding of abandonment is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

The address provided in the petition is different than the correspondence address of record. A courtesy copy of this decision will be mailed to the address in the petition. All future correspondence will be mailed solely to the address of record.

The application will be referred to Technology Center Art Unit 2854 for further processing.

² 398 F.2d 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

A handwritten signature in black ink, appearing to read "D. Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: Pennie & Edmonds LLP
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